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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/825,737	04/03/2001	David Orshan	ILEAP002	4101
7590 05/19/2005				
C. Douglas McDonal, Esq. Carlton Fields, et al. P.O. Box 3239 Tampa, FL 33601-3239		EXAMINER HARBECK, TIMOTHY M		
		ART UNIT 3628		PAPER NUMBER

DATE MAILED: 05/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/825,737

Applicant(s)

ORSHAN, DAVID

Examiner

Timothy M. Harbeck

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 6-7, 18-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Re Claim 6-7: These claims are rejected as being dependent upon themselves. It appears as if the applicant intended to refer to the method of the immediately preceding claim in both cases, and therefore for the purposes of examination will be considered as such.

Re Claim 18-20: It is unclear to the examiner how a computer program product can include a network of any kind, whether it is the Internet, a virtual private network or any other type. For the purposes of examination then, these claims cannot be accepted or rejected because a reasonable search of prior art cannot be performed.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 9, 17-20 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Re Claim 9 and 17-20: Software, programming, instructions or code not claimed as encoded on computer-readable media are descriptive material per se and are not statutory because they are not capable of causing functional change in a computer. When such descriptive material is recorded on some computer-

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readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases.

Furthermore, software, programming, instructions or code not claimed as being computer executable are not statutory because they are not capable of causing functional change in a computer. In contrast, when a claimed computer-readable medium encoded with a computer program defines structural and functional interrelationships between the computer and the program, and the computer is capable of executing the program, allowing the program's functionality to be realized, the program will be statutory.

Claims 9 and 17-20 are therefore rejected where there is no indication that the proposed software is recorded on computer-readable medium and/or capable of execution by a computer. Examiner suggests that the applicant incorporate into Claims 9 and 17-20 language that the proposed software is recorded on computer-readable medium and capable of execution by a computer to overcome this rejection.

Correction required. See MPEP § 2106 [R-2].

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arrko (US Patent No.6,584,500 B1).

Re Claim 1: Arrko discloses a method for billing a subscriber (user) to a network service that receives a request (i.e. data packet) from a network user and identifies the destination address of said request (Column 2, lines 19-20). Arrko goes on to disclose a method whereby said subscriber is billed based on a routing table containing a set of destination address ranges and a set of respective next hop network nodes (Column 2, lines 9-11). In other words, said subscriber is billed based upon the route in which said request travels, and the corresponding cost associated with said route.

Arrko references the Internet as comprising many communication links and networks interconnected by routers (Column 1, lines 19-20). From this reference of the Internet, while not explicitly stated, the system could be used through a number of routers over a number of networks that a request may travel. Arrko further notes that a high cost link in his method would connect the ISP network to foreign networks (Column 5, lines 11-13). The method of Arrko would therefore be able to utilize a first network and a second network based on the destination of said request.

Arrko also discloses a method wherein the transmission of said request could be tracked (Column 6, lines 26-34).

Finally Arrko discloses a method whereby the subscriber is billed from a first entity for requests utilizing a first network and billed from a second entity for requests utilizing a second network (Column 6, lines 62-64). In the method of

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Arrko, each router could be considered a different entity that connects different networks together. The subscriber would then be billed based on the use of each individual entity.

Re Claim 2: Arrko explicitly discloses the use of the Internet in his claimed method (Column 2, line 56-58).

Re Claim 3: Arrko discloses the use of other networks that could be separate from the Internet (Column 5, lines 10-14).

Claim 4 rejected under 35 U.S.C. 103(a) as being unpatentable over Arrko in view of Kikinis (Pub No. US 2001/0034758 A1).

Re Claim 4: Arkko discloses the claimed method supra but does not teach the explicit use of a Virtual Private Network. Kikinis discloses the use of a Virtual Private Network (Page 3, Paragraph 30); and therefore teaches that Virtual Private Networks were known to persons of ordinary skill in the art at the time of invention. It would have been obvious for someone skilled in the ordinary art at the time the invention was made to have modified Arrko by incorporating the Virtual Private Network, as was done by Kikinis. The motivation behind Arrko's system is to bill a subscriber for the use of various networks for the transmission of data. Without including these Virtual Private Networks in the billing process, the method described by Arrko would not be able to recoup the cost associated with providing the subscriber access to said Virtual Private Networks.

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Claim 5 rejected under 35 U.S.C. 103(a) as being unpatentable over Arrko in view of ("Lucent Technologies Expands Stinger Portfolio of DSL Products." Business Editors. Business Wire. New York: Nov 8, 2000. pg. 1).

Re Claim 5: Arrko discloses the claimed method *supra*, but does not teach the method whereby the receiving of a request from a user, determining the destination of said request and transmitting the request are carried out utilizing a module positioned within 1000 feet from the computer terminal. The article from the November 8, 2000 edition of *Business Wire* teaches a remote terminal (module) for Digital Subscriber Lines developed by Lucent that is designed to withstand harsh weather conditions and can be deployed outdoors in cabinets instead of the telephone company's central office. The article also notes "taking the DSL equipment out of the central office and placing it right in the neighborhoods we're serving solves that problem, and allows [Lucent] to increase their subscriber base." In achieving the goal of placing said remote terminals "right in the neighborhood," said remote terminals would be positioned within 1000 feet of said computer terminal. It would have been obvious for someone skilled in the ordinary art at the time of invention to have modified the method of Arrko to include the modules positioned within 1000 feet from the computer terminal, as done in the *Business Wire* article. In this way, the method of Arrko could provide broadband services at faster speeds by eliminating the distance limitations associated with Digital Subscriber Lines, which in turn would increase their customer base.

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Claims 6-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arrko in view of the *Business Wire* article as applied to claim 5 above, and further in view of Norberg ("DSL Delivery PacBell Brings Long-Awaited High-Speed Internet Access to Sonoma County." The Press Democrat. Santa Rosa, Calif.: Sept 6, 1999. D.1.).

Re Claim 6-7: Arrko in view of *Business Wire* discloses the claimed method except for the explicit disclosure wherein the module includes a multiplexer, and further wherein said multiplexer includes a digital subscriber line access multiplexer. Norberg discloses a Digital Subscriber Line Access Multiplexer (DSLAM) that separates the telephone analog and computer digital signals. It would have been obvious to someone skilled in the ordinary art to modify the system of Arrko in view of the *Business Wire* article to include a DSLAM, as done by Norberg, so that the telephone lines and information (computer) lines are not crossed and interfere with each other.

Claim 8 rejected under 35 U.S.C. 103(a) as being unpatentable over Arrko in view of Norberg.

Re Claim 8: Arrko discloses the claimed method as stated supra except for the specific reference that the tracking and billing of requests is carried out at a central module. Norberg explicitly states that a DSLAM is located at the telephone company central office. It would have been obvious for someone skilled in the ordinary art at the time of invention to modify the system of Arrko to include a central office, as noted by Norberg. It was known at the time of invention that digital subscriber lines were often routed through a central office.

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and therefore would have been a proper location to track and bill requests from customers, so that the customer would not receive an invoice and/or bill from each individual router (module) but instead would be given a compiled list of charges.

Regarding Claims 10-16

Further system claims would have been obvious from method claims rejected above (claims 2-8) and are therefore rejected using the same art and rationale.

Regarding Claim 17

A computer program product comprising computer code would have been obvious to enable the above method and system claims, claims 1 and 9 respectively, and is therefore rejected using the same art and the rationale.

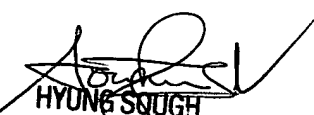
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Timothy M. Harbeck whose telephone number is 571-272-8123. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung S. Sough can be reached on 571-272-6799. The telephone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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